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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,891	08/25/2003	Yukio Hosaka	241903US0	1243

22850 7590 10/24/2005

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,891

Applicant(s)

HOSAKA ET AL.

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/2003, 10/31/2003, 3/31/2004, 4/24/2005
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 14-24 is/are pending in the application.
4a) Of the above claim(s) 15-24 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11, 14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/03, 3/31/04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II in the reply filed on April 26, 2005 is acknowledged.
2. Applicant's election, for search purposes, of the crosslinked ethylene vinyl acetate copolymer, cyclodextrin and crosslinked polyethylene species in the reply filed on August 15, 2005 is acknowledged.
3. Claims 15-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 15, 2005.

Claim Rejections - 35 USC § 112

4. Claims 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, line 1, "art" is queried.

In claims 11 and 14, it is unclear if or how "a" content of said ethylene vinyl acetate copolymer limits the claimed subject matter.

In claims 11 and 14, the metes and bounds of the "polymer having no functional group" are indeterminate in scope. As presently recited, said generic recitation reads on and does not distinguish over the ethylene vinyl acetate copolymer entity.

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In claim 14, it is unclear as to whether or not the "polymer having no functional group" is also subjected to the crosslinking treatment.

In claim 14, line 8, the basis upon which the content of ethylene vinyl acetate copolymer is determined, i.e., 100% by weight of "a material to be a water-soluble matrix", is indefinite and not understood.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,645,264 (Hasegawa et al).

Hasegawa et al disclose a composition for forming a polishing pad comprising A) a crosslinkable elastomer having no carboxyl, amino, hydroxyl, epoxy, sulfonic acid and phosphoric acid groups B) a water-insoluble substance and C) a water-soluble particulate substance. Suitable crosslinkable elastomers include ethylene vinyl acetate copolymer as well as other polymers having no functional groups, e.g., ethylene-propylene rubber. These crosslinkable elastomers may be used in combination (column 3, lines 11-19). The content of components (C) is preferably 5 to 50 volume percent based on 100 volume percent for (A), (B) and (C).

In essence, the disclosure of the reference differs from the present claims in not expressly exemplifying a combination of ethylene vinyl acetate polymer with another polymer having no functional group as the crosslinkable elastomer component. In this regard, it is maintained that it

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would have been obvious to one having ordinary skill in the art to combine both an ethylene vinyl acetate copolymer and another polymer having no functional group for their expected additive effect because the reference clearly teaches that combinations of said components can be used. It is prima facie obvious to combine two materials each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward

Primary Examiner

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